

REMARKS

Claims 1-4, 6-14, and 16-22 were pending in this application.

Claims 1-4, 6-14, and 16-22 have been rejected.

Claims 1-4, 6-14, and 16-22 remain pending in this application.

Reconsideration and full allowance of Claims 1-4, 6-14, and 16-22 are respectfully requested.

I. AMENDMENTS TO SPECIFICATION

The Office Action requests that the Applicants provide serial numbers for ten related patent applications. The Applicants have amended the specification to provide the serial numbers for the related applications.

II. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-10 and 21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,805,852 to Nakanishi et al. ("*Nakanishi*"). This rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d

531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Claim 1 recites “bypass circuitry” that includes a “plurality of bypass tristate line drivers” having “output channels” coupled to a “common read data channel” and a “multiplexer” having an “input channel” coupled to the “common read data channel.” The Office Action improperly asserts that tristate buffers (elements T1-T72) of *Nakanishi* anticipate both the “plurality of bypass tristate line drivers” and the “multiplexer” recited in Claim 1. (*Office Action, Pages 3-4, Section 7d*).

Claim 1 clearly recites two separate elements, a “plurality of bypass tristate line drivers” and a “multiplexer.” In order to anticipate Claim 1, *Nakanishi* must disclose a “plurality of bypass tristate line drivers” and a “multiplexer” as recited in Claim 1. The Office Action fails to show that *Nakanishi* discloses all of these elements of Claim 1. At most, *Nakanishi* simply recites the use of tristate buffers. The Office Action completely fails to show that *Nakanishi* recites a “multiplexer” that is coupled to the tristate buffers through a “common read data channel” as recited in Claim 1.

Moreover, Claim 1 recites that “output channels” of the “plurality of bypass tristate line drivers” are coupled to the “common read data channel.” Claim 1 also recites that the “multiplexer” has an “input channel” coupled to the “common read data channel.”

Nakanishi recites that multiple tristate buffers have outputs coupled to the same bus. For example, multiple tristate buffers (elements T1, T9, T17, T25, T33, T41, T49, and T57) are all coupled to a bus (element 1-1). (*Figure 3*). Based on this, the Office Action must rely on the bus (element 1-1) of *Nakanishi* as anticipating the “common read data channel” recited in Claim 1.

However, the Office Action must then show that a “multiplexer” in *Nakanishi* has an “input channel” coupled to the bus (element 1-1) of *Nakanishi*. The Office Action does not make this showing. In addition, the Office Action cannot make this showing. *Nakanishi* has absolutely no need for a multiplexer between the bus (1-1) and a latch (element L1) since the latch has only one input and is coupled to only one bus.

For these reasons, the Office Action fails to show that *Nakanishi* anticipates all elements of Claim 1 (and its dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 1-10 and 21.

III. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 11-20 and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Nakanishi* in view of U.S. Patent No. 4,591,973 to Ferris, III et al. (“*Ferris*”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d

1443, 1444 (*Fed. Cir. 1992*); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (*Fed. Cir. 1993*)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (*Fed. Cir. 1992*); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (*Fed. Cir. 1985*)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (*Fed. Cir. 1993*)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP* § 2142).

As described above in Section II, the Office Action does not establish that *Nakanishi* discloses, teaches, or suggests various elements of Claim 1. The Office Action therefore also does not establish that *Nakanishi* discloses, teaches, or suggests analogous elements recited in Claim 11. In addition, the Office Action does not show that *Ferris* discloses, teaches, or suggests these elements of Claim 11. As a result, the Office Action has not shown that the proposed *Nakanishi-Ferris* combination discloses, teaches, or suggests all elements of Claim 11.

For these reasons, the Office Action has not shown that the proposed *Nakanishi-Ferris* combination discloses, teaches, or suggests the Applicant's invention as recited in Claim 11 (and its dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 11-20 and 22.

IV. CONCLUSION

As a result of the foregoing, the Applicant asserts that all pending claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

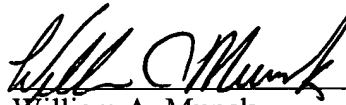
The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date:

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